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EXAMINER

REDDY, KARUNA P

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

1. Applicants' amendment filed 11/22/2010 has been fully considered; however, the amendment has not been entered given that it introduces new issues that would require further consideration and/or search.
2. With respect to new issue, claim 1 introduces the new limitation that acrylic elastomer "comprises a carboxylic group-containing acrylic elastomer consisting of a copolymer of at least one of an alkyl acrylate having an alkyl group of 1-8 carbon atoms and an alkoxyalkyl acrylate having an alkoxyalkyl group of 2-8 carbon atoms with a carboxyl group-containing unsaturated pound". This is in contrast to the earlier amended claim, filed on 6/23/2010, which recited "comprises an aliphatic unsaturated dicarboxylic acid monoalkyl ester copolymerized acrylic elastomer". Therefore, present amendment would require further consideration and/or search.
3. Given that the amendment is not being entered, applicant's arguments with respect to the amended claim, based on the possibility of entry of amendment are rendered moot. However, those arguments that are pertinent to the rejections of record which still stand given the non-entry of applicant's amendment are addressed in paragraph 4 below.

Response to Arguments

4. Applicant's arguments, filed 11/22/2010, have been fully considered but they are not persuasive. Specifically, applicant argues that (A) in the case of sulfur vulcanization in Aonuma et al, there is a description that 2-mercaptobenzothiazole can be used as a

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vulcanizing accelerator, however there are no examples where in sulfur vulcanization is carried out; (B) examiner states - while examples in instant application use "di-o-tolylguanidine vulcanization promoter" as a vulcanization promoter, Aunoma refers to the sulfur based compounds as vulcanizing agents. It seems as though examiner may infer that di-o-tolylguanidine is a sulfur based compound, however, this is not the case; and (C) data presented, in this amendment, show that polyvalent amine of instant claims is a vulcanizing agent, while the antiozonants of Aunoma et al (which read on vulcanizing agent of instant claims) cannot function as vulcanizing agent and do not have any crosslinking function.

With respect to (A), case law holds that "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." See *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." See *In re Nehrenberg*, 280 F.2d 161,126 USPQ 383 (CCPA 1960).

With respect to (B), to clarify, the statement is made in the context that instant claims are open to other components including sulfur based compounds of Aunoma et al referred to as vulcanizing agents, and di-o-tolylguanidine referred to as vulcanization promoter in instant invention.

With respect to (C), polyvalent amine of Aunoma et al is used in amounts of 2 pbw and 5 pbw, while polyvalent amine of instant invention is present in amounts of 1 pbw in example 2. For a proper comparison, inventive examples and comparative examples should use the same amount of polyvalent amine with other parameters being

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the same. Hence, it is not clear if the differences are related to the amount of polyvalent amine or the kind of polyvalent amine. In addition, it is noted that any data presented for consideration by the examiner should be presented in the form of an affidavit.

/K. P. R./

Examiner, Art Unit 1764

/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1764